



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,670	02/09/2004	Ramez Emile Nicola Shehada	064693-0097	1453

7590 06/01/2005
MCDERMOTT, WILL & EMERY
Suite 3400
2049 Century Park East
Los Angeles, CA 90067

EXAMINER

GIBSON, KESHIA L

ART UNIT PAPER NUMBER

3761

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,670

Applicant(s)

NECOLA SHEHADA, RAMEZ
EMILE

Examiner

Keshia Gibson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-7, 9, 10 and 12-15 is/are rejected.
7) ☒ Claim(s) 8 and 11 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 13 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/4/05 & 3/31/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it begins with implied language: "The present invention is directed to". It is suggested that this language be deleted; no substitute language is required. It is also suggested the last sentence (lines 3-6) be reworded such that the language "The invention" is not necessary. For example, "Modifications may be made to the surgical drain to improve stabilization..." Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 1 recites the limitation "the elongated circuit" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, "the elongated circuit" is considered to mean "the elongated conduit." Correction is required.

Art Unit: 3761

4. Claim 2 recites the limitation "fiberoptic" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, "fiberoptic" is considered to mean "optical fiber." Correction is required.

5. Claim 6 recites the limitation "the physiological property" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, Claim 6 is considered to depend from Claim 5. Correction is required.

6. Claim 11 recites the limitation "second and fourth optical fibers" in line 2 of the claim. There is insufficient antecedent basis for the "fourth optical fiber" in the claim. For purposes of examination, Claim 11 is considered to depend from Claim 10. Correction is required.

7. Claim 12 recites the limitation "the first sensing system" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, "the first sensing system" is considered to mean "the first optical fiber." Correction is required.

8. Claims 13-15 recite the limitation "the component" in each claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, Claims 13-15 are considered to depend from Claim 12.

9. Claims 6 and 11 are objected to because of the following informalities: the preamble recites "The system of claim 1," which lacks antecedent basis and is inconsistent with the preambles of the other claims. It is suggested that these preambles be changed to recite "The surgical drain of claim 1." Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-6, 9-10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US 3,866,599).

In regard to Claim 1, Johnson discloses a surgical drain 1 comprising an elongated conduit 2 configured to be implanted in and to drain from a body cavity (column 1, lines 7-10). The drain 1 further comprises a first optical fiber 11, 21, 27 and a second optical fiber 11, 21, 27; the fibers are configured to transmit and receive energy from body tissue (column 1, lines 20-25 and lines 44-49; column 2, lines 12-22 and lines 51-66). Johnson discloses multiple optical fibers, any of which may be considered a first optical fiber and a second optical fiber.

In regard to Claim 2, Johnson discloses that the optical fibers extend substantially parallel to each other; thus the distal ends of the optical fibers are substantially parallel to each other (Figs. 2-3 and 6).

In regard to Claim 3, Johnson discloses that the distal ends of the optical fibers are configured for insertion into tissue (column 2, lines 29-50).

In regard to Claim 4, Johnson discloses that the elongated conduit 2 further comprises a housing 20 extending from the conduit 2; the housing 20 supports the optical fibers 11,

Art Unit: 3761

21, 27 for insertion into the tissue (column 3, lines 6-9). Because the optical fibers 11, 21, 27 are embedded in the housing 20, the wall has been considered to inherently provide support for the fibers 11, 21, 27:

In regard to Claims 5-6, Johnson discloses that the drain comprises a sensing system that can sense physiological properties, including oxygenation and pressure (column 1, lines 44-49; column 2, lines 16-22 and 33-36).

In regard to Claim 9, Johnson discloses that the drain further comprises an oximeter that receives energy from the optical fibers 11, 21, 27 (column 2, line 62-column 3, line 5). The oximeter provides measurements, so it would have to display these measurements in some form to the user. Thus, the oximeter is considered analogous to a display.

In regard to Claim 10, Johnson discloses that the drain may further comprise third and fourth optical fibers 11, 21, 27 configured to deliver energy to and receive energy from tissue (column 1, lines 20-25 and lines 44-49; column 2, lines 12-22 and lines 51-68). Johnson discloses multiple optical fibers, any of which may be considered a third optical fiber and a fourth optical fiber.

In regard to Claim 12, Johnson discloses a surgical drain 2 that includes a component 11, 21, 27 affixed to the conduit 2 (Figs. 2-6; column 3, lines 6-9).

In regard to Claim 13, as discussed for Claim 4, Johnson discloses that the component 11, 21, 27 is embedded in the conduit (column 3, lines 6-9).

In regard to Claim 14, as discussed for Claims 5-6, Johnson discloses that the component 11, 21, 27 can sense physiological properties, such as oxygenation;

Art Unit: 3761

therefore the component 11, 21, 27 comprises a sensor (column 1, lines 44-49; column 2, lines 16-22 and 33-36).

In regard to Claim 15, as discussed for Claim 1, Johnson discloses that the component is an optical fiber (column 1, lines 20-25 and lines 44-49; column 2, lines 12-22 and lines 51-66).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Russo et al. (US 4,317,452).

Johnson et al. disclose a surgical drain 1 having a conduit configured to rest against a substantial length of tissue within the body cavity and having a lumen 22 (considered analogous to a drain hole) (Figs. 1-6; column 2, line 29- column 3, line 5). Johnson et al. disclose that claimed invention except for the conduit comprising a plurality of holes spaced along substantially the entire length of the drain portion. Russo et al. discloses a surgical drain comprising a conduit 10 having a plurality of holes along substantially the entire length of the drain portion (Fig. 1; column 2, lines 7-19; column 4, line 56-column 5, line). Russo et al. teach that having holes along a substantial portion of the conduit 10 allows body fluids in the cavity to pass into and along the conduit into a drainage

Art Unit: 3761

site. Johnson and Russo et al. are analogous art because they are within the same field of endeavor: surgical catheters/drains. Thus, it would have been obvious to one of ordinary skill in the to provide the surgical drain of Johnson with a plurality of holes, as taught by Russo et al., since doing so would allow for body fluid to be drained from a body cavity along a substantial length of the tube and/or from a substantial portion of the body cavity.

Allowable Subject Matter

14. Claims 8 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Polanyi (US 3,674,013), Shaw et al. (US 4,295,470), Maxwell (US 4,951,669), Fox et al. (US 5,041,108), Kosa et al. (US 5,335,305), and Bedingham (US 5,335,658 and US 5,421,328).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keshia Gibson whose telephone number is (571) 272-7136. The examiner can normally be reached on M-F 8:30 a.m. - 6 p.m., out of the office every other Friday.

Art Unit: 3761

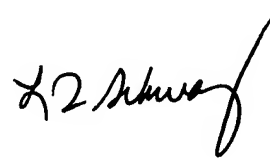
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Keshia Gibson
Examiner, Art Unit 3761

klg 5/19/05



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700